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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/628,455 07/31/00 REPP

R DON02 P-820

EXAMINER

PM82/0329

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REDMAN, J  
ART UNIT

PAPER NUMBER

3634  
DATE MAILED:

03/29/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/628,455

Applicant(s)

DEPP ET AL.

Examiner

JERRY BEDMAN

Group Art Unit

3634

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 1/19/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 2-35 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 2-35 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_.

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-35 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 36-50 of U.S. Patent No. 5,853,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent No. 5,853,895 claims a method of making and bonding a layer having adhesive and joint engaging member thereto but fails to recite the bonded joint to have a pull load greater than 150 pounds at a rate of 25 mm/min, a pull load greater than 250 pounds at a rate of 25mm/min, or a pull load after immersed in water at 80 degrees C for 100 hours. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the bonded joint of Patent No. 5,853,895 to have a pull load of at least 250 pounds at a rate of 25mm/min and to withstand a straight pull load after the bonded joint has been immersed in water at 80 degrees C for 100 hours since it would have been a matter of design choice provide a bonded joint to withstand a pull load of greater than 250 pounds at a rate of 25mm/min or to withstand a straight pull load after the bonded joint has been immersed in water at 80 degrees C for 100 hours and it is well known in the

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art to provide design modifications which solves any stated problem or is for any particular purpose and the bonded joint of Patent No. 5,853,895 would perform equally as well under a pull load of greater than 250 pounds at a rate of 25mm/min or to withstand a straight pull load after the bonded joint has been immersed in water at 80 degrees C for 100 hours.

Claims 2-35 are further rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,068,719. Although the conflicting claims are not identical, they are not patentably distinct from each other because Patent No. 6,068,719 claims a method of making and bonding a layer having adhesive and joint engaging member thereto but fails to recite the bonded joint to have a pull load greater than 150 pounds at a rate of 25 mm/min, a pull load greater than 250 pounds at a rate of 25mm/min, or a pull load after immersed in water at 80 degrees C for 100 hours. It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the bonded joint of Patent No. 6,068,719 to have a pull load of at least 250 pounds at a rate of 25mm/min and to withstand a straight pull load after the bonded joint has been immersed in water at 80 degrees C for 100 hours since it would have been a matter of design choice provide a bonded joint to withstand a pull load of greater than 250 pounds at a rate of 25mm/min or to withstand a straight pull load after the bonded joint has been immersed in water at 80 degrees C for 100 hours and it is well known in the art to provide design modifications which solves any stated problem or is for any particular purpose and the bonded joint of Patent No. 6,068,719 would perform equally as well under a pull

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load of greater than 250 pounds at a rate of 25mm/min or to withstand a straight pull load after the bonded joint has been immersed in water at 80 degrees C for 100 hours.

Applicant's arguments with respect to claims 2-35 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication should be directed to Jerry Redman phone number (703) 308-2168.

  
**Jerry Redman**  
**Primary Examiner**